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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/537,380

12/06/2005

Albin A. W. Baecker

ADMS 3668

8375

321 7590 08/21/2006

SENNIGER POWERS
ONE METROPOLITAN SQUARE
16TH FLOOR
ST LOUIS, MO 63102

EXAMINER

O HERN, BRENT T

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 08/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/537,380

Applicant(s)

BAECKER ET AL.

Examiner

Brent T. O'Hern

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1-17 and 19 in the reply filed on 31 July 2006 is acknowledged.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-4, 7-9, 11, 13 and 19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 8, 12-13 and 23 of copending Application No. 10/494,797. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '797 application teaches in claim 23, lines 2-3 "a staple and a nail to secure the location of the field liner on the pole".

One of ordinary skill in the art would have recognized that the claimed aspect of the nails and staples would have been substituted with the well known adhesive substance since these elements (nails, staples and adhesive substance) are securely attaching the objects. See col. 3, ll. 62-67 of US 5,626,551 to Kearns et al. which teaches the functional equivalence of staples and adhesive for fastening members together.

Therefore, it would have been obvious to one having ordinary skill in the art at the time applicants' invention was made to substitute the '380 application with a well known nails and staples since these elements have an equivalent function to secure two objects.

Thus one of ordinary skill in the art would have recognized the applicants' '797 subject matter encompassed the claimed subject matter as described above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-17 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "**applied thereto**" in claim 1, lines 10-11 and claim 2, lines 4-5, is vague and indefinite because it is unclear to one of ordinary skill in the art what is meant

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by "applied thereto". It is unclear whether the applicant is referring to the pole, the liner, a particular layer or something else.

The phrases "**inside thereof**" in claim 4, line 4, "**outside thereof**" in claim 4, line 5 and "**region thereof**" in claim 4, line 7, are vague and indefinite because it is unclear to one of ordinary skill in the art what is meant by "thereof". Regarding inside/outside thereof, it is unclear whether Applicant is referring to the first layer, second layer, sheet, liner or something else. Regarding the region, it is unclear whether the applicant is referring to any region on the pole or liner or something else.

Clarification and/or correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-14, 16-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baecker et al. (US 5,725,921) in view of Steele et al. (US 5,302,428).

Regarding claims 1 and 19, Baecker ('921) teaches a field liner (*col. 4, l. 44 and FIG-2, #26*) for protecting a timber pole against subsoil decay (*col. 4, l. 44 and col. 2, ll. 54-56*), which includes a sheet element (*col. 2, ll. 47-48*) in the form of a laminate structure (*col. 3, l. 44*) including a first layer of a flexible (*col. 2, ll. 46-53*), liquid impermeable (*col. 2, l. 58*), non-biodegradable (*col. 2, ll. 58-59*) synthetic plastics film material (*col. 2, ll. 46-53*) that contains a dry film biocide therein (*col. 2, l. 61*) and a

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second layer (*col. 2, ll. 57-59*) of a flexible, liquid impermeable, non-biodegradable synthetic plastics film material (*col. 2, ll. 57-59*) that is tear resistant (*col. 5, ll. 25-26*), however, fails to expressly disclose wherein an adhesive substance is applied.

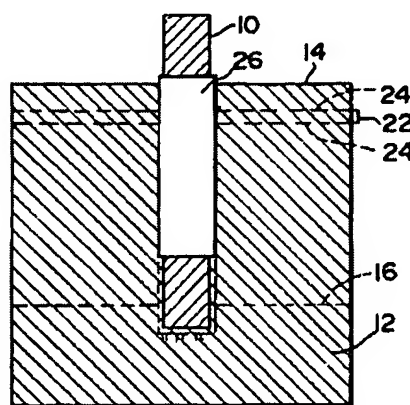


FIG. 2

However, Steele ('428) teaches an adhesive substance (*FIGs 3-4, #26 and col. 3, ll. 25-35*) for the purpose of holding down the liner and providing adhesion between the layers (*col. 3, ll. 34-35 and col. 4, ll. 31-36*).

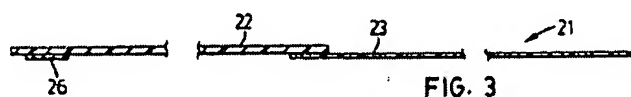


FIG. 3

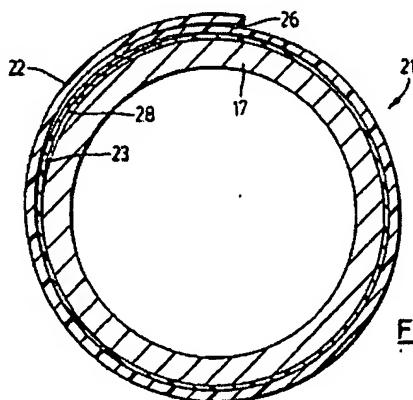


FIG. 4

Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to modify Baecker ('921) with an adhesive

substance as taught by Steele ('428) in order to provide a liner that is held down and adhered to the other layers.

The phrases "the sheet element being configured to permit wrapping thereof around a pole for covering the region of the pole to be protected" in claim 1, lines 8-10 and "that permits securing of the location of the sheet element on a pole when wrapped around the pole with its first layer abutting the pole by adhering the said region of the sheet element to an opposing region of the sheet element when wrapped around the pole" in claim 1, lines 11-15 are not given any patentable weight since the applicant is introducing **use limitations** into the product claims (*see MPEP 2173 (q)*).

Regarding claims 2-3, Baecker ('921) teaches a field liner in which the sheet element is configured to define a rectangular configuration that permits wrapping thereof around a pole by winding it on the pole (*col. 3, l. 44*), however fails to expressly disclose wherein the adhesive substance is applied as an adhesive strip along an operative longitudinal edge region.

However, Steele ('428) teaches an adhesive strip along an operative longitudinal edge region (*FIGs 3-4, #26 and col. 3, ll. 25-35*) for the purpose of holding down the liner and providing adhesion between the layers (*col. 3, ll. 34-35 and col. 4, ll. 31-36*).

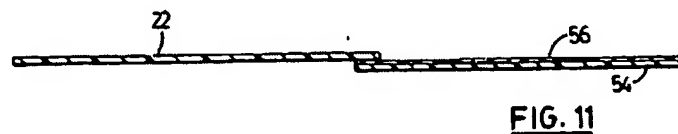
Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to modify Baecker ('921) with an adhesive strip along an operative longitudinal edge region as taught by Steele ('428) in order to provide a liner that is held down and adhered to the other layers.

The phrase “in which the sheet element is provided on a roll including a plurality of sheet elements, being separable from the roll by severing along a defined line of weakness” in claim 3, lines 1-4 are **process limitations** in a product claim and hence not given any patentable weight since patentability of a product does not depend on its method of production (see *MPEP* § 2173.05(p)).

Regarding claim 4, Baecker ('921) teaches a field liner in which the sheet element is configured to define an elongate sleeve (*col. 2, l. 47*) that has the first layer of material forming the operative inside and the second layer of material forming the operative outside (*col. 2, ll. 47-48*), however, fails to expressly disclose wherein the second layer of material having an adhesive substance applied to an external region.

However, Steele ('428) teaches second layer of material having an adhesive substance applied to an external region (*FIG 11 and col. 5, l. 44 to col. 6, l. 36*) for the purpose of holding down the liner and providing adhesion between the layers (*col. 3, ll. 34-35 and col. 4, ll. 31-36*).

Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to modify Baecker ('921) with a second layer of material having an adhesive substance applied to an external region as taught by Steele ('428) in order to provide a liner that is held down and adhered to the other layers.



The phrases “that permits loose location on a pole for covering the region of the pole to be protected and hence wrapping around the pole into a tight configuration of the sheet element on the pole” in claim 4, lines 5-8 and “that permits securing of the location of the sheet element in its said tight configuration on a pole when wrapped around the pole by adhering the said region to an opposing region of the sheet element when wrapped around the pole in the said tight configuration thereof” in claim 4, lines 10-15 are not given any patentable weight since the applicant is introducing **use limitations** into the product claims (*see MPEP 2173 (q)*).

Regarding claim 5, Baecker ('921) teaches a field liner in which one end of the sleeve defined by the sheet element is at least partially sealed to form a pocket (*col. 4, ll. 58-64*).

The phrases “the at least partially sealed end of the sleeve, in use, serving to determine the location of the sleeve on a pole by preventing the butt end of the pole to extend beyond the said at least partially sealed end of the sleeve” in claim 5, lines 3-7 are not given any patentable weight since the applicant is introducing **use limitations** into the product claims (*see MPEP 2173 (q)*).

Regarding claim 6, Baecker ('921) teaches a field liner in which the sheet element (*col. 2, ll. 47-48*), in its configuration in which it defines an elongate sleeve (*col. 2, l. 47*).

The phrase “is provided on a roll including a plurality of such sheet elements, being separable from the roll by severing along a defined line of weakness” in claim 6,

lines 3-5 are not given any patentable weight since the applicant is introducing **use limitations** into the product claims (see *MPEP 2173 (q)*).

Regarding claim 7, Baecker ('921) teaches a field liner in which the first layer of the sheet element is formed of polypropylene film (*col. 3, l. 15*).

Regarding claim 8, Baecker ('921) teaches a field liner in which the dry film biocide contained in the first layer of the sheet element (*col. 2, l. 61*)

The phrase "is of a type that provides for the protection of the sheet element against preservative-resistant micro organisms" in claim 8, lines 3-5 are not given any patentable weight since the applicant is introducing **use limitations** into the product claims (see *MPEP 2173 (q)*).

Regarding claims 9-10 and 13-14, Baecker ('921) teaches a field liner in which the first/second layer of the sheet element contains an insecticide compound (pyrethroid insecticide, Deltamethrin) (*col. 3, l. 19-23*).

Regarding claim 11, Baecker ('921) teaches a field liner in which the second layer of the sheet element is formed of one of low density polyethylene and high density polyethylene (*col. 2, l. 63*).

Regarding claim 12, Baecker ('921) teaches a field liner in which the second layer of material is formed of high density polyethylene that permits crimping of a segment of the sheet element that, in use, extends beyond the butt end of a pole around which the sheet element is wrapped (*col. 4, ll. 58-64 and col. 5, ll. 60-61*).

Regarding claim 16, Baecker ('921) teaches a field liner in which the adhesive substance comprises an adhesive sealant.

Regarding claim 17, Baecker ('921) teaches the liner discussed above, however, fails to expressly disclose wherein the adhesive substance is covered by a peel-off strip.

However, Steele ('428) teaches wherein the adhesive substance is covered by a peel-off strip (*FIGs-3-4, #26, col. 3, ll. 25-35 and col. 4, ll. 47-50*) for the purpose of applying additional materials to the underlying layers (*col. 4, ll. 47-50*).

Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to modify Baecker ('921) with an adhesive substance covered by a peel-off strip as taught by Steele ('428) in order to provide a liner that is capable of applying additional materials to the underlying layers.

The phrase "that can form a part of the field liner and that can be peeled-off prior to or during application of the field liner onto a pole" in claim 17, lines 3-5 is optional language, thus not limiting.

5. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baecker et al. (US 5,725,921) in view of Steele et al. (US 5,302,428) and Holt et al. (US 5,070,597).

Baecker ('921) teaches a field liner which includes a first layer and a second layer of the sheet element (*col. 3, l. 44*), however fails to expressly disclose a third layer of a flexible aluminum film that is vapour impermeable.

However, Holt ('597) teaches a flexible aluminum film (*col. 7, ll. 53 and 56*) that is vapour impermeable (*col. 7, l. 62*) for the purpose of providing a material that is flexible and a barrier to moisture (*col. 7, ll. 56 and 62*).


Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to modify Baecker ('921) with a flexible moisture water barrier aluminum as taught by Holt ('597) in order to provide a laminate that is flexible and a barrier to moisture.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brent T. O'Hern whose telephone number is (571) 272-0496. The examiner can normally be reached on M-F, 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-2172. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Brent T O'Hern
Examiner
Art Unit 1772
August 16, 2006


NASSER AHMAD
PRIMARY EXAMINER
8/16/06